



# UNITED STATES PATENT AND TRADEMARK OFFICE

*AP*

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,513	06/12/2001	Mark W. Slipp	495142000100	7749
20872	7590	09/08/2006	EXAMINER	
MORRISON & FOERSTER LLP 425 MARKET STREET SAN FRANCISCO, CA 94105-2482			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/881,513	<b>Applicant(s)</b> SLIPP ET AL.	
	<b>Examiner</b> David E. England	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 12 and 20 - 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 12 and 20 - 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

*DL*

### DETAILED ACTION

1. Claims 1 – 12 and 20 – 41 are presented for examination.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 – 12, 20 – 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Claims 1, 7, 20 and 34 – 36 recite the limitation of, “wherein the second content is provided to the first computer independent of a display size of the first computer,” is not disclosed anywhere in the application. In Applicant’s Remarks, they state where this limitation can be found. Examiner has viewed the cited areas and there is no disclosure that would state any section of the second content would specifically be independent of a display size of the first computer. Applicant is asked to specifically point to an area that does disclose this limitation, along with areas of the drawings or amend out this limitation.

5. All other claims are rejected for their dependents on the above independent claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 – 4, 7, 8, 10, 20 – 23 and 36 – 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanevsky U.S. Patent No. 6300947.

8. Referencing claim 1, as closely interpreted by the Examiner, Kanevsky teaches a method for inserting second content from a second computer into first content requested over the Internet by a user via an application running on a first computer the second content sent by the second computer over the Internet to the application running on the first computer for receipt by the user, the method comprising:

9. intercepting a request on an intermediate computer to establish a connection with the second computer sent by the first computer, (e.g., col. 10, line 36 – col. 11, line 24);

10. establishing a first connection between the intermediate computer and the first computer and establishing a second connection between the intermediate computer and the second computer, (e.g., col. 10, line 36 – col. 11, line 24);

11. receiving a request in the intermediate computer for the first content sent by the user via the application running on the first computer, (e.g., col. 10, line 36 – col. 11, line 24);

Art Unit: 2143

12. sending the request for the first content from the intermediate computer to the second computer, (e.g., col. 10, line 36 – col. 11, line 24);

13. receiving in the intermediate computer a response from the second computer containing the first content, (e.g., col. 10, line 36 – col. 11, line 24); and

14. sending the first content and the second content from the intermediate computer to the application running on the first computer for receipt by the user, (e.g., col. 10, line 36 – col. 11, line 24),

15. wherein the second content is provided to the first computer independent of a display size of the first computer, (e.g., col. 11, lines 14 – 64, “cookies”).

16. Referencing claim 2, as closely interpreted by the Examiner, Kanevsky teaches searching for a pre-determined rule for insertion based on the information contained in the request for content sent by the application running on the first computer to the second computer wherein the second content is sent to the application running on the first computer only if a pre-determined rule for insertion indicates that second content should be sent to the first computer, (e.g., col. 10, line 36 – col. 11, line 24).

17. Referencing claim 3, as closely interpreted by the Examiner, Kanevsky teaches searching for a pre-determined rule is performed prior to forwarding the request to the second computer, (e.g., col. 10, line 36 – col. 11, line 24).

Art Unit: 2143

18. Referencing claim 4, as closely interpreted by the Examiner, Kanevsky teaches searching for a pre-determined rule for insertion based on the information contained in the response sent by the second computer containing the first content wherein the intermediate computer sends the second content to the first computer only if a pre-determined rule for insertion indicates that the second content should be sent to the first computer, (e.g., col. 10, line 36 – col. 11, line 24).

19. Claims 7, 8, 10, 20 – 23 and 36 – 38 are rejected for similar reasons as stated above.

*Claim Rejections - 35 USC § 103*

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 5, 6, 9, 11, 12, 24, 25, 34, 35 and 39 – 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Shimbo et al. U.S. Patent No. 6092191 (hereinafter Shimbo).

22. As per claim 5, as closely interpreted by the Examiner, Kanevsky does not specifically teach prior to searching for a pre-determined rule for insertion:

23. checking IP address information associated with the request;

Art Unit: 2143

24. if the IP address information does not match pre-determined IP address information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion. Shimbo teaches prior to searching for a pre-determined rule for insertion:

25. checking IP address information associated with the request, (e.g. col. 20, line 55 – col. 21, line 23);

26. if the IP address information does not match pre-determined IP address information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion, (e.g. col. 20, line 55 – col. 21, line 23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Shimbo with Kanevsky because checking the IP address information to a specific rule regarding that IP address would allow the system to specifically target a node on the network for a specific type of rule to apply only to that IP address therefore personalizing rule for specific nodes along with group rules that would apply to all nodes on a network.

27. As per claim 6, as closely interpreted by the Examiner, Kanevsky does not specifically teach prior to searching for a pre-determined rule for insertion:

28. checking IP address information associated with the response;

29. if the IP address information does not match pre-determined IP address information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion.

30. Shimbo teaches prior to searching for a pre-determined rule for insertion:

Art Unit: 2143

31. checking IP address information associated with the response, (e.g. col. 20, line 55 – col. 21, line 23);

32. if the IP address information does not match pre-determined IP address information to which a rule for insertion might apply, forwarding the requested content to the first computer without searching for a pre-determined rule for insertion, (e.g. col. 20, line 55 – col. 21, line 23). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Shimbo with Kanevsky because of similar reasons as stated above.

33. Claims 9, 11, 12, 24, 25, 34, 35 and 39 – 41 are rejected for similar reasons as stated above in claims 1 – 10, 20 – 23 and 36 – 38 as they apply to 102 and/or 103 rejections.

34. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Numao et al. U.S. Patent No. 6647388 (hereinafter Numao).

35. As per claim 26, as closely interpreted by the Examiner, Kanevsky does not specifically teach the second content is transparent relative to the overall display and layout of the first content. Numao teaches the second content is transparent relative to the overall display and layout of the first content, (e.g., col. 14, lines 3 – 26 & 48 – 60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Numao with Kanevsky because the detection of the target to be written or changed is performed by a trial application of the conversion rule to the target document. Doing so would enable one to



Art Unit: 2143

watermark the document and actual processing is subsequently performed by the appropriate filter program.

36. Claims 27 – 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanevsky in view of Tso et al. (6421733) (hereinafter Tso).

37. As per claim 27, as closely interpreted by the Examiner, Kanevsky teaches a method for delivering second content to a user via an application running on a first computer who has requested first content over the Internet from a second computer the second content received by the application running on the first computer before the first computer receives the first content, the method comprising:

38. intercepting a request to establish a connection with the second computer sent by the application running on the first computer, (e.g., col. 10, line 36 – col. 11, line 24);

39. establishing a connection between the first computer and the intermediate computer, (e.g., col. 10, line 36 – col. 11, line 24);

40. establishing a connection between the second computer and the intermediate computer, (e.g., col. 10, line 36 – col. 11, line 24);

41. delivering the second content to the application running on the first computer for receipt by the user and via the intermediate computer, (e.g., col. 10, line 36 – col. 11, line 24);

42. receiving in the intermediate computer the first content from the second computer, (e.g., col. 10, line 36 – col. 11, line 24); and

Art Unit: 2143

43. sending the first content to the application running on the first computer, (e.g., col. 10, line 36 – col. 11, line 24), but does not specifically teach receiving in the intermediate computer a first request for the first content sent by the application running on the first computer, wherein the intermediate computer does not send the first request for the first content to the second computer;

44. receiving in the intermediate computer a re-request from the first content from the application running on the first computer, wherein the re-request for the first content from the application running on the first computer occurs after delivery of the second content to the first computer;

45. sending the re-request for the first content from the intermediate computer to the second computer after delivery of the second content to the first computer, wherein establishing the connection between the second computer and the intermediate computer occurs in response to the re-request for the first content from the first computer;

46. Tso teaches receiving in the intermediate computer a first request for the first content sent by the application running on the first computer, wherein the intermediate computer does not send the first request for the first content to the second computer, (e.g., col. 13, lines 36 – 67, “*caching system*”);

47. receiving in the intermediate computer a re-request from the first content from the application running on the first computer, wherein the re-request for the first content from the application running on the first computer occurs after delivery of the second content to the first computer, (e.g., col. 14, lines 21 – 64, “*not in cache*”);

Art Unit: 2143

48. sending the re-request for the first content from the intermediate computer to the second computer after delivery of the second content to the first computer, wherein establishing the connection between the second computer and the intermediate computer occurs in response to the re-request for the first content from the first computer, (e.g., col. 14, lines 21 – 64, “*not in cache*”). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Tso with Kanevsky because utilizing a proxy cache system enables a user to have quicker access to HTTP documents for frequent use as opposed to continually accessing web servers for content that is frequently requested. Not having a cache system could add latency to a system.

49. Claims 28 – 33 are rejected for similar reasons stated above with regards to Kanevsky.

### ***Response to Arguments***

50. Applicant's arguments with respect to claims 1 – 12, 20 – 41 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

51. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2143

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

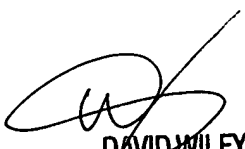
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. England  
Examiner  
Art Unit 2143

DE



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100